<u>U.S. Patent Application No. 09/843,145</u>   <u>Docket No.: 30014343-1 (1509-179)</u>

REMARKS

The indication of claims 12 and 38 containing allowable subject matter is noted.

Claims 35 and 36 have been amended for clarity.

Applicants traverse the rejection of claims 1-5, 7-11, 14, 27-31, 33 and 39 under 35 USC 103(a) as being unpatentable over Rautila et al., US Patent 6,549,625, in view of Scheer, US Patent Publication 2002/0161674. The Office Action admits the Rautila IP network 26 (including servers with databases, which the Office Action alleges is the equivalent of applicants' claimed broker) does not change message data of a reply transmitted from broker 26 to short range transceiver 14. The Office Action alleges transceiver 14 is the same as the claimed advertiser telecommunications device. The Office Action incorrectly relies on paragraph 0256 of Scheer to disclose "changing message data of the reply at the broker device." The Office Action then goes on to state it would have been obvious to one of ordinary skill in the art to have modified Rautila to change message data of the reply transmitted from IP network 26 to short range transceiver 14 "to deliver a updated message in response to a request of the recipient whenever he needs (sic)."

Consideration of Scheer, as a whole, indicates broker 10 of Scheer is entirely different from IP network 26 and the server(s) with database(s) of Rautila. In addition, a close reading of paragraph 0256 of Scheer indicates broker 10 does not disclose "changing message data of the reply at the broker device."

Concerning the latter point, the second sentence of paragraph 0256 of Scheer states:

11

The broker 10 also sends the "subscribe" performative to the distributor agent server 12 to inform the distributor to send status change messages when they occur.

This sentence thus states the broker asks the distributor to send change messages, when such messages occur. It does not state the broker sends status change messages when they occur. In other words, the broker advises the distributor, the broker is enabled to receive status change messages when such messages occur in the network; see paragraph 0246 of Scheer.

Further, broker 10 is entirely different from IP network 26. Broker 10 of Scheer is a device through which all network traffic is routed; see paragraph 0052. As such, broker 10 acts as a hub that links to the general purpose computing devices of supply chain participants such that all message traffic, whether it be agent messages or business transactions, is routed through the broker that functions as a hub in a hub and spoke type network; paragraph 0052.

Paragraphs 0058-0066 of Scheer describe details of broker 10. It is there indicated that broker 10 monitors the operational status of each agent server and acts as an intermediary to handle the receipt of messages and transactions from an original spoke to ensure that requests/messages and business transactions are routed to appropriate destinations. Paragraph 0053 indicates an agent server 12 is at each of the customer, distributor, supplier and carrier spokes. Paragraph 0059 indicates broker 10 operates transaction integrity services 48, while paragraph 0060 indicates broker 10 operates a publish and subscriber service 50. Paragraph 0061 states broker 10 translates between different exchange protocols, while paragraph 0062 indicates broker . 10 ensures and monitors reliable message delivery throughout the network including the

12

<u>U.S. Patent Application No. 09/843,145</u>   <u>Docket No.: 30014343-1 (1509-179)</u>

broker and agent servers 12. Paragraph 0063 states broker 10 includes several different directories/databases: namely, a master directory 52; agents and roles directory 54; brokerage status database 56 and publish/subscribe database 58.

Directory 52 includes a listing of all the major communication events supported over the network and has the definition and specifications of content and actions associated with sub-messages of each communications event, to enable a spoke to download a current version of the contents of directory 52. Broker 10 also uses the specifications to determine what has to be monitored and managed for each communication event from the perspective of broker 10.

Paragraph 0064 indicates broker 10 uses the agents and roles directory 54 to maintain a readiness status of each spoke and service on a particular spoke. Broker status database 56 is stated in paragraph 0065 to track the passing of messages and business transactions through the broker. As fulfillment or completion progress is made by the various spokes and communicated back to broker 10, the broker records and changes the status in the broker status database. Upon the completion of a message or business transaction, broker 10 removes the entry from the brokerage status database and places it into an archive audit/log database or file. The publish/subscribe database 58 of broker 10 tracks the current publishers and subscribers for each type publishable within a network. Paragraph 0066 also indicates broker 10 performs maintenance utility functions that a system administrator uses to maintain databases and parameter tables, as well as systems management functions that the system administrator uses to monitor and manage broker 10 and the overall state of the network.

13

<u>U.S. Patent Application No. 09/843,145</u>   <u>Docket No.: 30014343-1 (1509-179)</u>

Based on the foregoing, broker 10 is entirely different from IP network 26. In addition, broker 10 is entirely different from the broker of applicants' application. To this end, claim 1 has been amended to indicate the broker device is an advertisement broker device. Clearly, the "broker" device 10 of Scheer cannot be considered as an advertisement broker device.

Applicants can also not agree with the alleged motivation for modifying Rautila as a result of Scheer. The Office Action alleges the motivation for such a modification is "to deliver a updated message in response to a request of the recipient whenever he needs. (sic)" Frankly, attorney for applicants cannot understand what is meant by the quoted statement. Explanation is in order. For example, who is the "recipient"? In addition, what is meant by "whenever he needs."?

For all the foregoing reasons, claim 1 is not made obvious by Rautila and Scheer. Consequently, claims 2-5, 7-11, 14, 27-31, 33 and 39, all of which depend on Rautila et al. are not rendered obvious by the combination of Rautila et al. and Scheer. In addition, some of these claims define features that are not found in the art relied on by the Examiner. For example, the rejection of claims 4 and 5 states Rautila discloses broadcasting an advertisement from a man portable advertiser device and claim 5 indicates the advertiser device is a hand-holdable portable device. The Office Action states this feature is disclosed by position transceiver 14 of Rautila. The Examiner is requested to indicate where specifically in Rautila such a disclosure can be found.

In the rejection of claim 7, the Office Action alleges Rautila discloses a method wherein advertiser device 14 does not include its own telecommunication address in its broadcast advertisements. The Office Action relies on Fig. 3 and column 6, lines 48-60,

14

<u>U.S. Patent Application No. 09/843,145</u>   <u>Docket No.: 30014343-1 (1509-179)</u>

and column 8, lines 63-67, for this feature. Applicants are unable to find any mention in the relied upon portion of Rautila for this feature. In fact, column 8, lines 63-67, specifically indicates mobile terminal 12 displays information received from transceiver 14, i.e., the advertiser device per the Office Action, and that this information includes the identification of transceiver 14.

The Office Action states column 6, lines 23-47, of Rautila indicates the advertiser device 14 is any of a mobile telephone, personal digital assistant, or other small portable electronic device. Applicants are unable to find any mention in column 6, lines 23-47, of Rautila indicating position transceiver 14 has such characteristics. Explanation is in order.

Claim 31 is stated to be rejected for the same reasons discussed above with respect to claim 1. It has been previously pointed out why the combination of Rautila and Scheer to reject claim 1 is incorrect. In particular, it has been pointed out why "broker" device 10 of Scheer cannot be considered as similar to the IP network 26 of Rautila.

The rejection of claim 31 then goes on to state Rautila discloses communicating a reply message from a broker device, i.e., IP network 26, to an advertiser device, i.e., position transceiver 14, and that the broker device changes the message sent by the consumer device, i.e., mobile terminal 12, by augmenting the message in the reply message sent by device 12 to network 26. See column 10, lines 1-8, 58-64, to understand how the features of column 5, lines 39-51, of Rautila read on the drawings.

15

Consideration of these portions of Rautila indicates the allegations in the Office Action are incorrect. Column 10, lines 1-8, indicates the server in IP network 26 checks the signature, decrypts the transmission of information from mobile terminal 12, which the Examiner equivocates to applicants' consumer device, and determines if a time stamp is valid. If all this information is verified, the server within IP network 26 concludes with a high probability that the user of mobile terminal 12 is an authorized user and provides the user of mobile terminal 12 with access to the database. In other words, there is a communication to mobile terminal 12, rather than a communication from the IP network including database 26 to position transceiver 14, i.e., which the Office Action equivocates to applicants' advertiser device, described in column 10, lines 1-8.

Column 10, lines 58-64, of Rautila, indicates the server in network 26 associated with database 102 responds to identification information transmitted over link 24 from mobile terminal 12, which the Examiner equivocates to applicants' consumer device, to enable the user of terminal 12 to learn more about the goods or services or other information associated with individual information resources 50 of the broadcast locations 25 of Fig. 2; see column 6, lines 59 and 60. Again, there is no mention in column 10, lines 58-64, of any communication from the IP network including database 26 to position transceiver 14. Hence, there is no disclosure in this portion of Rautila of a reply message communicated from the IP network including database 26, which the Examiner equivocates to applicants' broker device, to position transceiver 14, which the Examiner equivocates with applicants' advertiser device. Consequently, this portion of Rautila et al. does not disclose the features of claim 31.

16

U.S. Patent Application No. 09/843,145   **Docket No.: 30014343-1 (1509-179)**

Column 5, lines 39-51, discloses that a database checks the validity of a signature, decrypts information which is received from a network and checks validity of a time stamp. This has reference to activity performed by the IP network including database 26, in the preferred embodiment. Column 5, lines 39-51, goes on to state that if the time stamp and signature are valid, the database transmits the stored information associated with the identification information to the second transceiver. Column 4, line 59, indicates the second transceiver is in the mobile terminal, i.e., mobile terminal 12 of the specific embodiment. In essence, column 5, lines 39-51, summarizes in slightly different terminology, the action described in column 10, lines 58-64. Consequently, the limitations of claim 31 relating to a reply message communicated from a broker device to an advertiser device being changed by the broker device changing message data sent by a consumer device are not disclosed in column 5, lines 39-51, of Rautila. Based on the foregoing, the rejection of claim 31 is wrong.

The rejection of claim 39 is based on the same portions of Rautila as are relied on for the rejection of claim 31. This rejection is wrong because claim 39 requires the reply message communicated from the broker device to the advertiser device to be changed by the broker device changing the message data sent by the consumer device by deleting some of the message data in the reply message sent by the consumer device to the broker device. As previously discussed, the relied upon portions of Rautila et al. fail to disclose communicating a reply message from a broker device to an advertiser device, wherein the reply message is changed by the broker device. Further, there is no disclosure in Rautila et al. of deleting message data in a reply message communicated from a broker device to an advertiser device.

17

<u>U.S. Patent Application No. 09/843,145</u>   <u>Docket No.: 30014343-1 (1509-179)</u>

Applicants again challenge the ability of the Examiner to rely on Scheer as a valid reference against applicants' claims. Applicants assert that the Examiner cannot rely on the Scheer published application or the Scheer provisional application without proof that the contents of the Scheer provisional application were known in the US prior to applicants' filing date.

The present application was filed April 27, 2001. Scheer was filed May 29, 2001, and is related to Provisional Application Serial No. 60/263,317, filed January 22, 2001. It is applicants' position that the Patent and Trademark Office is not entitled to the benefit of the January 22, 2001, filing date of the provisional application insofar as it concerns the published Scheer application filed May 29, 2001. It is applicants' position that the benefits of 35 U.S.C. §119(e) inure only to the benefit of an applicant and that the Patent and Trademark Office is entitled to rely on the filing date of a provisional application only by proving the provisional application complies with the 35 USC 102(a) requirement that "the invention was known or used in this country" before applicants' filing date.

The situation regarding the benefits provided by 35 U.S.C. §119(e) are similar to those of 35 U.S.C. §119(a)-(d). *In re Hilmer*, 359 F.2d 859, 149 U.S.P.Q. 480 (CCPA 1966), held that the benefits under 35 U.S.C. §119(a)-(d) are only for the benefit of a foreign applicant, not for the benefit of the Patent and Trademark Office in applying a reference. The title of 35 U.S.C. §119 is "Benefit of earlier filing date; right of priority." Use of the words "benefit" and "right of priority" indicate the benefits of 35 U.S.C. §119 are limited to the applicant, in the same way foreign priority rights are limited to applicants, per Hilmer.

Consideration of 35 U.S.C. §119(e) shows Congress intended for the benefits of

18

<u>**U.S. Patent Application No. 09/843,145**</u>   <u>**Docket No.: 30014343-1 (1509-179)**</u>

35 U.S.C. §119(e) to be confined to the applicant. 35 U.S.C. §119(e)(2) states that if the fee for filing the provisional application is not paid, the provisional application may not be relied upon in any proceeding before the Patent and Trademark Office. If the benefits under 35 U.S.C. §119(e) were not so limited, the Patent and Trademark Office would not be able to rely on the provisional application. Because it is illogical for the ability of the Patent and Trademark Office to depend on a provisional application only if the applicant paid the fee, this portion of the statute indicates Congress intended the benefits to be limited to the applicant, in concert with the Hilmer holding.

Similarly, the contingencies set forth in 35 U.S.C. §119(e)(1) indicate the benefits are intended only for the applicant of the provisional application. In this regard, 35 U.S.C. §119(e)(1) indicates there are no benefits attached to the provisional application if the regular application is not filed within 12 months of the provisional application. Further, if the regular application does not contain or is not amended to contain a specific reference to the provisional application, there are no benefits under 35 U.S.C. §119(e). Because these contingencies are similar to those regarding foreign applicants, the analogy with Hilmer holds.

These provisions indicate Congress intended to limit the benefits under 35 U.S.C. §119(e) to applicants. It is illogical for the Patent and Trademark Office to be able to use a provisional application only if an applicant performs specific acts, notably causing a regular application to contain a specific reference to the provisional application and/or filing the regular application within 12 months of the provisional.

Based on the foregoing, the Examiner's use of the Scheer published application and provisional application (without proof of knowledge of the contents of the provisional in

19

the US before applicants' filing date) as a reference against applicants' claims is wrong.

Applicants traverse the rejection of claims 1-5, 7-11, 14, 17-31, 33 and 39 as being unpatentable over Rautila et al. in view of Todd, US Patent 6,785,682. This rejection is the same as the rejection of the same claims based on Rautila et al. and Scheer. The only difference between the two rejections is that the Examiner relies on Todd to disclose the feature the Examiner admits Rautila et al. does not disclose, that is, "changing message data of the reply at the broker device." The changed reply message is sent from the broker device to the advertiser device. To meet the requirement to communicate the changed reply message from the broker device to the advertiser device, the Examiner relies on column 7, lines 1-10, of Rautila et al. This portion of Rautila et al. indicates acknowledgement of payment is sent from database 26 of the IP network, which the Examiner equivocates to applicants' broker device, to position transmitter 14, which the Examiner equivocates to applicants' advertiser device.

One of ordinary skill in the art would not have modified the IP network including database 26 of Rautila et al. as a result of the disclosure by Todd of a message broker that is used in a lazy messaging system and method; see column 1, lines 13 and 14 of Todd. While column 5, lines 58-65, of Todd indicates the message broker disclosed by Todd may cause changes in the underlying data structure of the message broker by associating or adding one message to another, replacing a previously stored message with a newly received message, updating a currently stored message with a newly received message, updating a currently stored message with a newly received message or creating a new message within the data structure, the Todd message broker is so different from the IP network of Rautila et al. that one of ordinary skill in the art would

20

<u>U.S. Patent Application No. 09/843,145</u>   <u>Docket No.: 30014343-1 (1509-179)</u>

not have made the substitution. In addition, the Todd message broker is entirely different from the advertisement broker device now required in claim 1.

The Office Action alleges the motivation for modifying the Rautila et al. network that includes database 26 is "to deliver a modified message in response to a request of the recipient whenever he needs." This is the same motivation that was set forth in connection with the rejection of the claims based on Rautila et al. and Scheer. The Examiner must explain this motivation because the language employed in connection with the motivation is incomprehensible.

Dependent claims 2-5, 7-11, 14, 17-31, 33 and 39 are rejected in the rejection based on Rautila et al. and Todd on the same basis that these claims are rejected on Rautila et al. and Scheer. These dependent claims are therefore allowable for the same reasons advanced previously in connection with the rejection based on Rautila et al. and Scheer.

Applicants traverse the rejection of claims 20, 21 and 32 as being unpatentable over Rautila et al. in view of Konishi, US Patent 5,301,273. The Office Action indicates Rautila et al. is deficient with regard to claim 20, upon which claims 21 and 32 depend, because Rautila et al. does not disclose a server that ensures, at least initially, that no telecommunications address of an advertiser or replier of an advertisement is passed with a message that is transmitted by the server. The Office Action states such a feature is disclosed by column 2, lines 52-58, of Konishi. However, column 2, lines 52-58, of Konishi indicates that when address information is not used for a predetermined time period, due to movement or failure of a destination station, a response message corresponding to the message transmitted using this address information, is not

21

received and the address information is deleted from the address translation table and the message is transmitted again by broadcast. Such a statement has nothing to do with replying to an advertisement or a telecommunication address of an advertiser or replier. Consequently, one of ordinary skill in the art would not have modified Rautila et al. as a result of Konishi to meet the requirements of claim 20.

Claims 21 and 32 are allowable with claim 20, upon which claims 21 and 32 depend. In addition, the Office Action has failed to consider the requirements of dependent claims 21 and 32. There is nothing in the Office Action indicating that either Rautila et al. or Konishi discloses storing a direct telecommunication address of a provider of a message and to recall that address and forward it to a remote telecommunications device if a release signal has been received by a server. Further, the Office Action fails to attempt to establish a *prima facie* case with respect to claim 32 that indicates the server is adapted to remove the telecommunications address from at least one of advertisement data and a reply message to ensure that no telecommunication address of the advertiser or replier is passed with the message transmitted by the server.

Claim 22 has been amended for clarity to indicate the broker device is adapted to selectively pass (a) advertiser details to the consumer device and consumer details to the advertiser device, or to pass both advertiser details to the consumer device and consumer details to the advertiser device. In other words, claim 22, as amended, indicates that the broker device can (1) during one interval, pass advertiser details, (2) during a second interval pass consumer details, and (3) during a third interval pass both advertiser and consumer details. The foregoing amendment precludes the

22

<u>U.S. Patent Application No. 09/843,145</u>   <u>Docket No.: 30014343-1 (1509-179)</u>

interpretation set forth in the next to last full paragraph on page 14 of the Office Action. Consequently, the rejection of claims 22, 25, 26 37, 40 and 41 as being unpatentable over Rautila et al. in view of Paltenghe et al., US Patent Publication 2001/0011250, is incorrect. This rejection is incorrect vis-à-vis claim 22, as amended, for the reasons just previously discussed. In other words, claim 22 is not rendered obvious by the combination of Rautila et al. and Paltenghe et al.

Claims 25, 26, 37, 40 and 41 that depend on claim 22 are allowable with claim 22. In addition, some of these claims include features not disclosed by the references relied on to reject them. For example, claim 26 requires each of the telecommunications devices of the network of claim 22 to include a hybrid mobile telephone. The Office Action alleges Rautila et al. discloses this feature in column 8, lines 49-52. Column 8, lines 49-52, however, merely indicates network transceiver 46 of mobile device 12 might be a cellular transceiver. There is no mention of IP network 26 or device 14 of Rautila et al. being a hybrid mobile telephone in column 8, lines 49-52.

In the rejection of claim 37, the Office Action admits Rautila does not disclose blocking passage of the address of an advertiser device to a consumer device. For clarity, claim 37 has been amended to indicate blocking of passage of the advertiser device to the consumer device by the broker device is during passing of details of the advertiser to the consumer device. The reliance in the Office Action on Paltenghe et al., paragraph 0026, for this feature is incorrect.

Paragraph 0026 does not indicate passage of the address of advertiser devices to consumer devices is blocked. Instead, this paragraph indicates consumers can

23

search, shop and negotiate anonymously. While paragraph 0026 indicates fuzzy logic matching can be used to match merchant and consumer on an anonymous basis so that neither knows the identity of the other, there is nothing in this paragraph indicating passage of the address of an advertiser device to a consumer device is blocked during passing of details of the advertiser to the consumer device as a result of a communication from a broker device to a consumer device.

Applicants traverse the rejection of claim 34 as being unpatentable over Rautila et al., in view of Paltenghe et al. and further in view of Konishi. The Office Action states claim 34 is rejected for the same reasons discussed with regard to claim 20. However, claim 20 has been rejected only as a result of a combination of Rautila et al. and Konishi. The Examiner has failed to establish a *prima facie* case of obviousness in making this rejection. In addition, the proposed combination is incorrect because of the deficiencies pointed out *supra* in connection with the rejection of claim 20, based on Rautila et al. and Konishi and the rejection of claim 22, upon which claim 34 depends.

Applicants traverse the rejection of claims 35 and 36 as being unpatentable over Rautila et al., in view of Scheer and further in view of Paltenghe. Claims 35 and 36 are stated to be rejected for the same reasons as discussed above with respect to claims 22 and 37. Again, the Examiner has not attempted to attempt to establish a *prima facie* case of obviousness because he has provided no rationale for combining the references. In addition, this rejection is incorrect for the reasons discussed *supra* in connection with the rejections of claims 22 and 37.

Applicants traverse the rejection of claims 35 and 36 as being unpatentable over Rautila et al., in view of Todd and further in view of Paltenghe et al. In this rejection,

24

<u>U.S. Patent Application No. 09/843,145</u>   <u>Docket No.: 30014343-1 (1509-179)</u>

claims 35 and 36 are stated to be rejected for the same reasons discussed above with respect to claims 22 and 37, respectively. Again, such a rejection does not establish a *prima facie* case of obviousness. Further, the rejection of claims 35 and 36 is incorrect for the same reasons discussed *supra* in connection with the rejection of claims 22 and 37.

In view of the foregoing amendments and remarks, favorable reconsideration and allowance are respectfully requested and deemed in order.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 08-2025 and please credit any excess fees to such deposit account.

Respectfully submitted,

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25